UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,605	01/25/2001	Glenn Ricart	300/2	4396

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EXAMINER
HANNE, SARA M

ART UNIT	PAPER NUMBER
2179	

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/769,605	RICART ET AL.
	Examiner	**Art Unit**	
	Sara M. Hanne	2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>05 April 2006</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-5 and 7-15* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-5 and 7-15* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to the amendment received on April 5, 2006. Claims 1-

5 and 7-15 are pending in the application.   Claims 6 and 16 were cancelled in the

claims filed November 3, 2003.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

3.   Claims 1-5 and 7-15 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention. Claims 1 and 12 recite the phrase "in a

durable way". The term "durable" is meant to describe something with tangible strength

or capability to withstand wear or decay. What is durable about information?

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> (e) the invention was described in a patent granted on an application for patent by another filed in the
> United States before the invention thereof by the applicant for patent, or on an international application
> by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this
> title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act

of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior

to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5.   Claims 1-4 and 7-9 are rejected under 35 U.S.C. 102(e) as being anticipated by

East et al., U.S. Patent Publication No. 2003/0061323.

In accordance with Claim 1, East et al. discloses sending a generic server

personalization information for personalizing the server, storing the personalization

information on the server in a durable way ("a non-volatile memory such as a magnetic

media, e.g., a hard drive, or optical storage.", Par. 39) and sending the server

personalization information for personalizing a client of the server ("remote/master

administrative server 202B controls updates for thin clients 200C-D and remote

administrative server", Pg. 4, Par. 50) and storing the information for personalizing the

client on the client in a durable way ("a non-volatile memory such as a magnetic media,

e.g., a hard drive, or optical storage.", Par. 39).

Claim 2 teaches that the information sent must be at least one of "the server's

name, the domain in which it resides . . ." etc. taught by East et al. by configuring the

network ("changing TCP/IP configurations", Pg. 5, Par. 54).

Claim 3 also teaches that the information sent can be Windows operating system

registry information. East et al. teaches this limitation by installing a new device ("an

operating system update, the addition of a new device driver, a change in device

settings", Pg. 4, Par. 50). Also, the background art in this patent application does refer

to prior art listed on novell.com in the form of software that can collect the Desktop

policies and profiles, which would include registry information and corporate policy
information.

As in Claim 7, East et al. further discloses the server to receive and durably store
("a non-volatile memory such as a magnetic media, e.g., a hard drive, or optical
storage.", Par. 39) the personalization information for the Server and for the Client, the
server personalizing itself according to this information, sending the Client it's
information, and the Client personalizing itself based on the information it receives
("Remote/master administrative server 202B then conveys the update to remote server
202C and thin clients 200C-D. Remote server 202C then conveys the update to thin
clients 202E-N.", Pg. 5, Par. 50) and to durably store the client personalization
information ("a non-volatile memory such as a magnetic media, e.g., a hard drive, or
optical storage.", Par. 39).

As in Claim 4, East et al. teaches personalizing the server after the client has
been personalized as seen in the rejection of Claim 7 *supra*. Therefore the system
ignores workstation requests for personalization until the server is personalized.

As in Claim 8, East et al. teaches the client to be a laptop disconnectable from
the server ("LAN 104 may include a number of interconnected computer systems and
optionally one or more other devices: for example, one or more workstations 110a, one
or more personal computers 112a, one or more laptop or notebook computer systems
114, one or more server computer systems 116, and one or more network printers
118.", Pg. 3, Par. 36).

As in Claim 9, East et al. teaches a higher-tier server that receives

personalization information for the client's server and provides this information back to

the server after the server receives and durably stores ("a non-volatile memory such as

a magnetic media, e.g., a hard drive, or optical storage.", Par. 39) it and at least

partially personalizes itself using this information ("an administrative server is a

computer that controls updates and configurations for one or more other administrative

servers and/or one or more thin clients", Pg. 4, Par. 50).

Claim Rejections - 35 USC § 103

6.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

8.   Claim 5 and 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable

over East et al., U.S. Patent Publication No. 2003/0061323.

As in Claim 5, East et al. teaches personalizing the client as seen in the rejection

of Claim 7 *supra.* East et al. fails to teach ignoring user requests until the client is at

least partially personalized as recited in the claims. It would be obvious to one of

ordinary skill in the art to ignore user requests temporarily until the client has been

personalized at least partially. One would have been motivated to make such a

combination because a personalization method that is executed long enough so that it

may complete the request of the user would have been obtained.

As in Claims 10 and 11, East et al. teaches transmission of Roles and

Workstation information as further described in Claim 7 of the application seen *supra.*

East et al. fails to teach one piece of information to be dominate or submissive to

another. It would be obvious to one of ordinary skill in the art to make a specific piece

of information, roles workstation or user information, dominate or submissive. One

would have been motivated to make such a combination because a personalization

method for controlling the order in which the information is processed would have been

obtained.

As in Claim 12, East et al. teaches collecting and storing server and client

personalization information pertaining to the existing server and client, sending the

personalization information to a new server (Copy Configuration, Pg. 5, Par. 56-58) to

personalize the server with the other server's information, storing the personalization

information by the server in a durable way ("a non-volatile memory such as a magnetic

media, e.g., a hard drive, or optical storage.", Par. 39, sending the personalization information for the Client to a new client to personalize the client with the other client's information ("plug-and-play customization for new clients.", Pg. 6, Par. 60) and storing the personalization information that pertains to the client in a durable way ("a non-volatile memory such as a magnetic media, e.g., a hard drive, or optical storage.", Par. 39). East et al. fails to teach the new client/server to be replacements for the old client/server. It would be obvious to one of ordinary skill in the art to remove the old client/server and replace them with the new ones that have a copy of the old client/server's personalization information. One would have been motivated to make such a combination because a personalization method that can remove old hardware would have been obtained.

Further in reference to Claim 13, East et al. teaches the personalization information to be stored with a remote service provider (Remote/master administrative server 202B).

In reference to Claim 14, East et al. teaches the personalization information to include roles information (Figure 8 clusters, and MAC address), net information ("network management information can be transferred", Pg. 8, Par. 90), client information (Claim 7 rejection *supra*) and user information ("change in device settings", Pg. 4, Par. 50).

In reference to Claim 15, East et al. teaches the role information comprising personalization information common to or driven by roles or functions within a company. They further teach the net information comprising personalization information common

to a workgroup, network, or server, along with client information comprising

personalization information specific to the client and user information comprising

information specific to a user (see Claim 14 rejection, *supra*).

Response to Amendment

Applicant's arguments filed 4/5/06 have been fully considered but they are not

persuasive.

In response to applicant's argument that the references fail to show certain

features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., "survives re-booting the client or server" and "relogging into a server by a client or

subserver", page 2 of arguments) are not recited in the rejected claim(s). Although the

claims are interpreted in light of the specification, limitations from the specification are

not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed.

Cir. 1993).

In response to applicant's argument that the references fail to show durable

storage or personalization information, the examiner disagrees. The section recited by

the applicant that the applicant claims to be teaching away from the storage or

information on page 8 of the submitted remarks, refers to the Background section of

East et al. and not the actual disclosure of the invention. Furthermore, East et al.

teaches a memory medium including "a non-volatile memory such as a magnetic media,

e.g., a hard drive, or optical storage." (Par. 39) which qualifies as more than just RAM.

Just because a client is a thin client does not been that it fails to store anything

permanently. There is limited storage, but there are degrees of thinness of a thin client.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara M. Hanne whose telephone number is (571) 272-4135. The examiner can normally be reached on M-F 7:30am-4:00pm, off on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WEILUN LO can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

smh

BA HUYNH
PRIMARY EXAMINER